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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD D. HALLIBURTON and
JACK PEARSON

Appeal 2009-010257
Application 10/777,770
Technology Center 3700

Before STEVEN D.A. McCARTHY, STEFAN STAICOVICI and
FRED A. SILVERBERG, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ronald Halliburton and Jack Pearson (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision to finally reject under 35 U.S.C. § 103(a) claims 1-12, 29 and 30 as unpatentable over Thacher (US 5,917,725, issued Jun. 29, 1999) and Kelly (US 5,882,258, issued Mar. 16, 1999); claims 13 and 15-27 as unpatentable over Thacher, Kelly and Spaur (US 6,196,920 B1, issued Mar. 6, 2001); and claim 14 as unpatentable over Thacher, Kelly and Mothwurf (US 5,919,090 issued Jul. 6, 1999). Appellants present additional evidence in the Declaration of Jack Pearson[1,2]. Claims 28 and 31 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6.

THE INVENTION

Appellants' invention relates to an electronic device and methods of playing solitaire that allows the game to be played on the Internet in a tournament format. Spec. 1, ll. 7-9 and figs. 8a-8c and 9.

Claim 1 is representative of the claimed invention and reads as follows:

> 1. A method for playing a computer-based Klondike-style solitaire game in a tournament framework comprising,
>
> selecting a tournament event having predetermined entry criteria and game features from a game menu,
>
> wherein said entry criteria comprises a tournament start time,

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[1] For the purpose of this appeal, we shall consider that the Declaration of Jack Pearson (a co-inventor of this application), filed Aug. 10, 2005, was filed under 37 C.F.R. § 1.132. *See* MPEP § 716.

[2] Hereafter referred to as the "Pearson Declaration."

retrieving input over the internet regarding said tournament event including data to generate a random card sequence and instructions to enable said game features associated with said selected tournament event from a server to a personal computer after said tournament start time and before a tournament ending event, wherein said game features comprise game rules and game patterns to extend play, and graphic elements,

playing and scoring solitaire games according to said input by moving cards from play stacks to a column or an ace stack or between said columns in said personal computer and said score is based in part on the speed that a player successfully makes a move,

transmitting scores from said personal computer over the internet to a server after said game is complete and before said tournament ending event occurs,

comparing said score to the scores of other players that are entered into said tournament event, and, in the event that said transmitted score is determined to be a winning score, transmitting information comprising the game play sequence, and

displaying said scores on a website that can be accessed by said players, and wherein said personal computer only receives input from said internet server, before and after said solitaire game.

SUMMARY OF DECISION

We REVERSE.

OPINION

The obviousness rejection over Thacher and Kelly

Claims 1-10, 29 and 30

Independent claim 1 is drawn to a method for playing a computer-based Klondike-style solitaire game in a tournament framework that requires the step of "transmitting information comprising the game play sequence." Br., Claims Appendix. The Examiner found that central computer 6 (server) of Thacher's electronic game tournament system can set variable/selectable information transmission times, i.e., game start and end times. Ans. 4. In Thacher, central computer 6 (server) compares the scores of players in a tournament, determines the winning score (i.e., the winner) and initiates transmission of a winner announcement to each of the video games involved in that particular tournament. See Thacher col. 8, ll. 3-9. Although we appreciate the Examiner's position that Thacher's system transmits information at variable/selectable times, we could not find any portion of Thacher and the Examiner has not pointed to any portion that discloses specifically transmitting the "game play sequence." Thus, we find that the Examiner has not provided an adequate basis in fact and/or technical reasoning that would support the Examiner's finding that Thacher's system discloses transmitting the "game play sequence," as called for by claim 1.

As such, Thacher does not disclose all the limitations of independent claim 1 and the addition of Kelly does not remedy the deficiencies of Thacher as discussed above. For the foregoing reasons, the rejection of independent claim 1 and dependent claims 2-10, 29, and 30 under 35 U.S.C. § 103(a) as unpatentable over Thacher and Kelly cannot be sustained. *See In re Fine,* 837 F.2d 1071, 1076 (Fed. Cir. 1988).

Claims 11 and 12

Claim 11 recites a "network connection *only* retrieving input and comparing scores during at least one of before and after the play of the particular game." Similarly, claim 12 requires that "said player's computer *only* receives said input prior to playing a game." Br., Claims Appendix. Emphasis added. Appellants argue that the combination of Thacher and Kelly does not disclose these limitations. Br. 14 and 16.

The Examiner found that the network tournament system of Thacher can set variable/selectable information transmission times for the system. Ans. 4. Hence, according to the Examiner a person of ordinary skill in the art would have readily appreciated that setting variable/selectable information transmission times allows information to be transmitted before and after game play.

Although we appreciate the Examiner's position, nonetheless, claims are construed with an eye toward giving effect to all terms in the claim. *Bicon Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006). In this case, claims 11 and 12 require that input is retrieved or received, respectively, *only* at least one of before or after playing a game, as per claim 11, or *only* prior to playing a game, as per claim 12. In contrast, Thacher discloses transmitting information at variable/selectable times, i.e., before, during, and after playing a game.

The Examiner has thus not established that Thacher discloses retrieving or receiving input *only* at least one of before or after playing a game, as per claim 11, or *only* prior to playing a game, as per claim 12. The addition of Kelly does not remedy the deficiencies of Thacher as described. For the foregoing reasons, the rejection of independent claims 11 and 12

under 35 U.S.C. § 103(a) as unpatentable over Thacher and Kelly cannot be sustained.

The obviousness rejections over Thacher, Kelly and Spaur or Mothwurf

The addition of either Spaur or Mothwurf does not remedy the deficiencies of Thacher and Kelly as discussed above. As such, the rejections under 35 U.S.C. § 103(a) of claims 13 and 15-27 as unpatentable over Thacher, Kelly and Spaur and of claim 14 as unpatentable over Thacher, Kelly and Mothwurf likewise cannot be sustained.

The Pearson Declaration

Since we have determined that the Examiner has failed to articulate a rational underpinning to support the combination of the teachings of the prior art in the manner claimed, we do not need to reach the evidence of secondary considerations of non-obviousness submitted by the Appellants.

DECISION

The decision of the Examiner to reject claims 1-27, 29, and 30 is reversed.

REVERSED

JRG